

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

REMARKS

Review and reconsideration on the merits are respectfully requested. Applicants have amended claim 1 in accordance with a preferred embodiment of the invention, wherein the copolymer incorporated into the rubbery polymer comprising the pressure-sensitive adhesive layer, is further defined as indicated. In particular, the copolymer is defined in accordance with the disclosure in the first full paragraph beginning on page 5, and more specifically the sentence bridging pages 5-6 of the specification. Entry is respectfully requested.

In paragraph 3 at page 2, claims 1 and 2 stand rejected under 35 U.S.C. 102(e), as allegedly being anticipated by Shibata et al. The Examiner notes that the present inventive entity overlaps with the inventive entity named in this reference. Shibata et al is commonly assigned with the present application.

The Shibata et al publication was filed in the U.S. on February 29, 2001, subsequent to the filing date of Applicant's Japanese priority application. Applicants submit herewith a Declaration Under 37 CFR § 1.55(b), and accompanying sworn translation of Japanese Patent Application No. 2000-173048, which was filed in Japan on June 9, 2000. The certified copy of the Japanese language priority application was submitted on August 30, 2001 and its filing has been acknowledged by the Examiner.

The subject matter of present claims 1 and 2 is disclosed in the prior application; see, for example, page 1, claims 1 and 2, and pages 4-5, paragraph [0010]. Accordingly, Applicants have perfected their claim to the foreign priority application with respect to the subject matter of

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

the pending claims. Thus, the pending claims are entitled to an effective filing date of June 9, 2000, and the Shibata et al document does not qualify as prior art against the present claims.

Accordingly, reconsideration and withdrawal of the rejection based on Shibata et al is respectfully requested.

In the paragraph bridging pages 2-3, claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Matsui et al, U.S. Patent 5,601,917.

Matsui discloses a paint film-protective sheet including a supporting substrate having thereon a rubber-based pressure-sensitive adhesive layer including a rubber-based polymer. One issue appears to be whether Matsui discloses the addition of Applicant's presently claimed copolymer to the pressure-sensitive adhesive layer. In this regard, the Examiner relies on the alkyl phenol resin, characterized as an additive by Matsui, and disclosed in column 4. In column 6, the Examiner points to lines 14-21, wherein a terpene-denatured phenol resin is described, among other types of phenol series resins used as the high-polar additive in Matsui.

This rejection is respectfully traversed.

Matsui does not disclose or suggest Applicant's claimed sheet for protecting a paint film, wherein the rubber-based pressure-sensitive adhesive layer comprises a rubbery polymer and incorporated therein at least one copolymer selected from the group as defined in claim 1. While the Examiner points to disclosure of a terpene-denatured phenol resin and an alkyl phenol resin as an additive, Applicants respectfully submit that Matsui fails to teach or suggest the incorporation of a particular type of copolymer as presently defined in Applicant's claim 1, much less the particular advantages obtained by the present invention. In this regard, Applicants

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

discovered that the use of the particular types of copolymers as defined provides the significant advantages as described in the specification. For example, the sheet is less apt to peel off by itself, is less apt to leave fouling substances on the paint film and therefore no cleaning treatment of the paint film is necessary following peeling off of the protective sheet. Further, the Examples versus Comparative Examples in the specification clearly support these discoveries with respect to the anti-fouling aspects of the present invention.

Thus, one of ordinary skill in the art would have had no motivation to modify Matsui's disclosure to allegedly arrive at the present invention, and no motivation to do so is apparent in the document itself.

For the foregoing reasons, Applicants respectfully submit that Matsui does not defeat the patentability of Applicant's claims. Accordingly, withdrawal of this rejection is respectfully requested.

In paragraph 6, claims 1 and 2 stand rejected under 35 U.S.C. 103(b) as allegedly being anticipated by Dobashi et al. The Examiner indicates that Dobashi is believed to be an English language equivalent of JP A-6-73352 cited on page 2 of Applicant's specification.

Again, one issue appears to be whether the Dobashi reference discloses the addition of Applicant's presently claimed copolymer. The Examiner has pointed to numerous particular locations in the reference where various resins or polymers are disclosed as additives. For example, among tackifiers which can be used are terpene resins or terpene-phenol resins (see the paragraph bridging columns 4 and 5), which is stated to be a copolymerization product of a terpene as a main monomer with a phenol.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

This rejection is respectfully traversed.

Dobashi et al do not teach or suggest a sheet for protecting a paint film, wherein the rubber-based pressure-sensitive adhesive layer comprises a rubbery polymer having incorporated therein at least one copolymer selected from the group defined in Applicant's claim 1. While the Examiner has pointed to terpene or terpene-phenol resins as tackifiers, none of these materials meets the definition of copolymer as set forth in the present claims. Accordingly, since Dobashi et al do not disclose or suggest the subject matter claimed, from a materials standpoint, Dobashi et al could not have appreciated the advantages which are obtained in accordance with the present invention. Thus, one of ordinary skill in the art would have had no motivation to modify Dobashi's disclosure to allegedly arrive at the present invention, and no motivation to do so is apparent in the document itself.

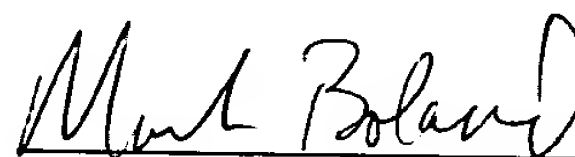
For the foregoing reasons, reconsideration and withdrawal of the rejection in paragraph 6 is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

A Petition for a two-month extension of time, and check for the requisite extension fee, are submitted herewith. The USPTO is directed and authorized to charge any additional fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Mark Boland
Registration No. 32,197

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: January 13, 2003

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/874,314

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claim 1 as follows:

1. (Amended) A sheet for protecting a paint film, said sheet comprising a substrate and formed on one side thereof a rubber-based pressure-sensitive adhesive layer which comprises a rubbery polymer and incorporated therein [a copolymer of at least one aromatic compound with at least one terpene compound or aliphatic hydrocarbon compound] at least one copolymer selected from the group consisting of styrene/hydrogenated terpene copolymer resins, phenol/hydrogenated terpene copolymer resins, hydrogenated aliphatic/aromatic copolymer petroleum resins and aliphatic/aromatic copolymer petroleum resins.